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REMARKS

The foregoing amendments and the following remarks are responsive to the February 9, 2005 Final Office Action. Claims 1, 8-10, 14, 15, and 18-20 remain as previously presented, Claims 2-7, 11-13, 16, and 17 remain as originally filed, and Claim 21 is amended. Thus, Claims 1-21 are presented for further consideration.

Request for Entry

Applicants submit that the foregoing amendments merely provide antecedent basis for Claim 21, and do not introduce any new issues. Applicants respectfully request the Examiner to enter the amendments and to reconsider the claims in view of the following remarks.

Response to Objection to the Drawings

In the February 9, 2005 Final Office Action, the Examiner objects to the drawings under 37 C.F.R. § 1.83(a) as not showing every feature of the invention specified in the claims. In particular, the Examiner states that the limitation of “receives at least a portion of a previously recorded video data stream ... while continuing to record the external video data stream for the video program segment” must be shown in the drawings or the feature(s) canceled from the claim(s).

Applicants submit that the originally-filed drawings satisfy the requirements of 37 C.F.R. § 1.83(a). For example, originally-filed Figure 2 schematically illustrates a video recording system 10 in accordance with an embodiment of the present invention. Figure 2 schematically illustrates that user input 22 is received by the user interface 20 of the video recording system 10, and that the user interface 20 is coupled to the video data management system 50 in order to communicate the user input 22 to the video data management system 50. (See, page 4, lines 8-23 of the present application.) Figure 2 also has a double-headed arrow connecting the video data management system 50 to the isochronous interface 40 and a double-headed arrow connecting the isochronous interface 40 to the external hard disk drive 42. In this way, Figure 2 schematically illustrates that the video data management system 50 sends streaming video data over the isochronous interface 40 to the external hard disk drive 42 and receives streaming video data over the isochronous interface 40 from the external hard disk drive 42. Figure 2 also schematically illustrates that the video data management system 50 transmits video output through the video output interface 60 to the television 62 for display to the user. (See, page 10, line 28 – page 11, line 1 of the present specification.)

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The present specification further explains at page 4, lines 8-12 that (emphasis added):

By receiving user input 22, the user interface 20 permits the user to indicate to the video recording system 10 which video program segments 34 are selected for recording from the external video data stream 32, **as well as to control various other operation parameters of the video recording system 10, such as playback commands (e.g., pause, instant-replay, etc.).**

These features involve receiving previously-recorded video data streams from the external rotating storage drive **while continuing to record** the external video data stream for the video program segment, as recited by Claim 1. Furthermore, the present specification at page 1, lines 12-18 explains that by utilizing hard disk drive technology, video recording systems, such as personal video recorders, “allow users to pause and resume live television or to observe instant-replay **while continuing to record** the same incoming video data stream.”

Thus, by schematically illustrating a video recording system 10 which utilizes hard disk drive technology to provide pause and instant-replay operations of live television, Figure 2 schematically illustrates an embodiment which “receives at least a portion of a previously recorded video data stream from the at least one external rotating storage drive via the interface while continuing to record the external video data stream for the video program segment.” Therefore, Applicants submit that the originally-filed drawings show every feature of the invention specified in the claims, in accordance with 37 C.F.R. § 1.83(a). Applicants respectfully request that the Examiner withdraw the objection to the drawings.

Response to Rejection of Claims 1-21 Under 35 U.S.C. § 112, First Paragraph

In the February 9, 2004 Final Office Action, the Examiner rejects Claims 1-21 under 35 U.S.C. § 112, first paragraph as failing to comply with the written description requirement. The Examiner states that the claim limitation “receives at least a portion of a previously recorded video data stream ... while continuing to record the external video data stream for the video program segment” in Claims 1 and 15 was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventors had possession of the claimed invention at the time the application was filed.

As described above with respect to the objection to the drawings, Applicants submit that the specification clearly discloses all the limitations of Claims 1-21. Therefore, Applicants submit that Claims 1-21 satisfy the written description requirement of 35 U.S.C. § 112, first

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paragraph, and Applicants respectfully request that the Examiner withdraw the rejection of Claims 1-21 and pass these claims to allowance.

Response to Rejection of Claim 21 Under 35 U.S.C. § 112, Second Paragraph

In the February 9, 2005 Final Office Action, the Examiner rejects Claim 21 under 35 U.S.C. § 112, second paragraph as having insufficient antecedent basis for the limitation “the encrypted streaming video data.” As described herein, Applicants have amended Claim 21 to depend from Claim 17, thereby providing antecedent basis for the limitation. Applicants submit that amended Claim 21 satisfies the requirements of 35 U.S.C. § 112, second paragraph, and Applicants respectfully request that the Examiner withdraw the rejection of Claim 21 and pass Claim 21 to allowance.

Response to Rejection of Claims 1, 5, 6, 8-11, 15, and 20 Under 35 U.S.C. § 103(a)

In the February 9, 2005 Final Office Action, the Examiner rejects Claims 1, 5, 6, 8-11, 15, and 20 under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 5,991,832 issued to Sato et al. (“Sato”) in view of U.S. Patent No. 6,782,188 issued to Ido et al. (“Ido”).

Claim 1

The Examiner states that Sato discloses all the limitations of Claim 1, except for “receives at least a portion of a previously recorded video data stream from the at least one external rotating storage drive via the interface while continuing to record the external video data stream for the video program segment.” However, the Examiner states that Ido teaches such a limitation, and that it would be obvious to one of ordinary skill in the art to incorporate the capability of editing video signals as taught by Ido into the system disclosed by Sato.

Applicants submit that there is no suggestion to combine the teachings of Sato and Ido to produce the system recited by Claim 1. Obviousness can only be established where there is some teaching, suggestion, or motivation to combine or modify the teachings of the prior art to produce the claimed invention. See In re Fine, 837 F.2d 1071 (Fed. Cir. 1988); M.P.E.P. Section 2143.01, page 2100-125, February 2003 revision. To support the Examiner’s assertion of obviousness, the Examiner must provide clear and particular findings as to the reason one skilled in the art, with no knowledge of the claimed invention, would have selected these components and combined them in the manner claimed. See, e.g., In re Kotzab, 217 F.3d 1365, 1371 (Fed. Cir. 2000).

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There is no teaching or suggestion in the prior art that the video recording system of Sato would benefit in any way from the sequential-access videotape editing system disclosed by Ido. The system disclosed by Sato is designed for home use to record television programs for later viewing. The system disclosed by Ido is designed for editing together a plurality of original videotape materials to produce television programs to be broadcasted. Neither Sato nor Ido discloses any motivation to modify the home video recording system of Sato to provide the capabilities of editing together multiple videotape materials as disclosed by Ido. Therefore, there is no suggestion in the prior art to modify the system of Sato with the teachings of Ido. Without a teaching or suggestion in the prior art of the desirability of the combination, the Examiner's assertion that it would be obvious to one of ordinary skill in the art to incorporate the capability of editing video signals as taught by Ido into the system disclosed by Sato is an impermissible use of hindsight derived from the teachings of the present application. See, e.g., In re Dembiczak, 175 F.3d 994, 999 (Fed. Cir. 1999).

Furthermore, the prior art must provide a suggestion that the combination of teachings would have a reasonable expectation of success. See, e.g., In re Vaeck, 947 F.2d 488, 20 U.S.P.Q.2d 1438 (Fed. Cir. 1991); In re Dow Chemical Co., 837 F.2d 469, 5 U.S.P.Q.2d 1529 (Fed. Cir. 1988). Even if the system disclosed by Sato were used for videotape editing, there is not a reasonable expectation of success since the combination would not provide the capabilities of the system recited by Claim 1. Exemplary capabilities of the system recited by Claim 1 which are not provided by the combination of Sato and Ido include time-shifting by pausing and resuming live television, and instant-replay of live television. As discussed by the present application at page 1, lines 12-21 (emphasis added):

Video recording systems, such as personal video recorders, typically utilize hard disk drive technology to store and replay video images. Such hard disk drive technology has traditionally been used in computer-related applications. By coupling the large, yet finite, storage capability (e.g., 15 GB or more) and non-volatile memory of an internal hard disk drive and video compression and decompression capabilities, **personal video recorders allow users to pause and resume live television or to observe instant-replay while continuing to record the same incoming video data stream. These capabilities are not provided by video cassette recorders that utilize magnetic tape storage, which is a sequential access medium** (i.e., to jump from a particular stored video data stream to another, the tape must be advanced or rewound.)

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Therefore, a combination of the system disclosed by Sato with the videotape editing system of Ido does not have a reasonable expectation of success. Furthermore, if the video-disk-based embodiment disclosed by Sato were used for video editing, there is not a reasonable expectation of success since such a video-disk-based system would be random-access, rather than sequential access, so there would be no need for the system disclosed by Ido.

Applicants therefore submit that Claim 1 is patentably distinguished over the combination of Sato in view of Ido. Applicants respectfully request that the Examiner withdraw the rejection of Claim 1 and pass Claim 1 to allowance.

Claims 5, 6, 8-11, and 20

Each of Claims 5, 8-11, and 20 depends from Claim 1, and Claim 6 depends from Claim 5. Thus, each of Claims 5, 6, 8-11, and 20 includes all the limitations of Claim 1, as well as other limitations of particular utility. For the reasons stated above with respect to Claim 1, Applicants submit that each of Claims 5, 6, 8-11, and 20 is patentably distinguished over the combination of Sato in view of Ido. Applicants respectfully request that the Examiner withdraw the rejection of Claims 5, 6, 8-11, and 20 and pass these claims to allowance.

Claim 15

For the reasons stated above with respect to Claim 1, Applicants submit that Claim 15 is patentably distinguished over the combination of Sato in view of Ido. Applicants respectfully request that the Examiner withdraw the rejection of Claim 15 and pass Claim 15 to allowance.

Response to Rejection of Claims 2, 3, 12, 13, 16, and 17 Under 35 U.S.C. § 103(a)

In the February 9, 2005 Final Office Action, the Examiner rejects Claims 2, 3, 12, 13, 16, and 17 under 35 U.S.C. § 103(a) as being unpatentable over Sato in view of Ido and further in view of U.S. Patent No. 5,990,927 issued to Hendricks et al. ("Hendricks").

As described above, Applicants submit that each of Claims 1 and 15 is patentably distinguished over the combination of Sato in view of Ido. Applicants further submit that Hendricks does not disclose the limitations of Claims 1 or 15 which are not taught or suggested by the combination of Sato in view of Ido. Therefore, Applicants submit that Claims 1 and 15 are patentably distinguished over the combination of Sato in view of Ido in further view of Hendricks.

Each of Claims 2, 12, and 13 depends from Claim 1, and Claim 3 depends from Claim 2. Thus, each of Claims 2, 3, 12, and 13 includes all the limitations of Claim 1, as well as other

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limitations of particular utility. Each of Claims 16 and 17 depends from Claim 15, so each of Claims 16 and 17 includes all the limitations of Claim 15, as well as other limitations of particular utility. Therefore, Applicants submit that each of Claims 2, 3, 12, 13, 16, and 17 are patentably distinguished over the combination of Sato in view of Ido in further view of Hendricks. Applicants respectfully request that the Examiner withdraw the rejection of Claims 2, 3, 12, 13, 16, and 17 and pass these claims to allowance.

Response to Rejection of Claims 4 and 7 Under 35 U.S.C. § 103(a)

In the February 9, 2005 Final Office Action, the Examiner rejects Claims 4 and 7 under 35 U.S.C. § 103(a) as being unpatentable over Sato in view of Ido and further in view of U.S. Patent No. 6,016,507 issued to Carroll et al. ("Carroll").

As described above, Applicants submit that Claim 1 is patentably distinguished over the combination of Sato in view of Ido. Applicants further submit that Carroll does not disclose the limitations of Claim 1 which are not taught or suggested by the combination of Sato in view of Ido. Therefore, Applicants submit that Claim 1 is patentably distinguished over the combination of Sato in view of Ido in further view of Carroll.

Claim 7 depends from Claim 6, which depends from Claim 5, which depends from Claim 1. Claim 4 depends from Claim 3, which depends from Claim 2, which depends from Claim 1. Thus, each of Claims 4 and 7 includes all the limitations of Claim 1, as well as other limitations of particular utility. Therefore, Applicants submit that each of Claims 4 and 7 is patentably distinguished over the combination of Sato in view of Ido in further view of Carroll. Applicants respectfully request that the Examiner withdraw the rejection of Claims 4 and 7 and pass these claims to allowance.

Response to Rejection of Claims 14 and 18 Under 35 U.S.C. § 103(a)

In the February 9, 2005 Final Office Action, the Examiner rejects Claims 14 and 18 under 35 U.S.C. § 103(a) as being unpatentable over Sato in view of Ido and further in view of U.S. Patent No. 5,815,631 issued to Sugiyama et al. ("Sugiyama").

As described above, Applicants submit that each of Claims 1 and 15 is patentably distinguished over the combination of Sato in view of Ido. Applicants further submit that Sugiyama does not disclose the limitations of Claims 1 or 15 which are not taught or suggested by the combination of Sato in view of Ido. Therefore, Applicants submit that each of Claims 1

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and 15 is patentably distinguished over the combination of Sato in view of Ido in further view of Sugiyama.

Claim 14 depends from Claim 1, so Claim 14 includes all the limitations of Claim 1, as well as other limitations of particular utility. Claim 18 depends from Claim 15, so Claim 18 includes all the limitations of Claim 15, as well as other limitations of particular utility. Thus, each of Claims 14 and 18 is patentably distinguished over the combination of Sato in view of Ido in further view of Sugiyama. Applicants respectfully request that the Examiner withdraw the rejection of Claims 14 and 18 and pass these claims to allowance.

Response to Rejection of Claim 19 Under 35 U.S.C. § 103(a)

In the February 9, 2005 Final Office Action, the Examiner rejects Claim 19 under 35 U.S.C. § 103(a) as being unpatentable over Sato in view of Ido and further in view of Sugiyama and German Patent No. DE 3106125A1 issued to Wieland ("Wieland").

As described above, Applicants submit that Claim 15 is patentably distinguished over the combination of Sato in view of Ido. Applicants further submit that Sugiyama and Wieland do not disclose the limitations of Claim 15 which are not taught or suggested by the combination of Sato in view of Ido. Therefore, Applicants submit that Claim 15 is patentably distinguished over the combination of Sato in view of Ido in further view of Sugiyama and Wieland.

Claim 19 depends from Claim 18, which depends from Claim 15. Thus, Claim 19 includes all the limitations of Claim 15, as well as other limitations of particular utility. Therefore, Applicants submit that Claim 19 is patentably distinguished over the combination of Sato in view of Ido in further view of Sugiyama and Wieland. Applicants respectfully request that the Examiner withdraw the rejection of Claim 19 and pass Claim 19 to allowance.

Response to Rejection of Claim 21 Under 35 U.S.C. § 103(a)

In the February 9, 2005 Final Office Action, the Examiner rejects Claim 21 under 35 U.S.C. § 103(a) as being unpatentable over Sato in view of Ido and further in view of Wieland and Hendricks.

As described above, Applicants submit that Claim 15 is patentably distinguished over the combination of Sato in view of Ido. Applicants further submit that Wieland and Hendricks do not disclose the limitations of Claim 15 which are not taught or suggested by the combination of Sato in view of Ido. Therefore, Applicants submit that Claim 15 is patentably distinguished over the combination of Sato in view of Ido in further view of Wieland and Hendricks.

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Claim 21 depends from Claim 17, which depends from Claim 15. Thus, Claim 21 includes all the limitations of Claim 15, as well as other limitations of particular utility. Therefore, Applicants submit that Claim 21 is patentably distinguished over the combination of Sato in view of Ido in further view of Wieland and Hendricks. Applicants respectfully request that the Examiner withdraw the rejection of Claim 21 and pass Claim 21 to allowance.

Summary

For the foregoing reasons, Applicants submit that Claims 1-21 are in condition for allowance, and Applicants respectfully request such action.

Respectfully submitted,

Dated: _____

4/14/05

By: _____



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